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August 11, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re:		
	Application No.:	10/603,266
	Confirmation No.:	7160
	Art Unit:	2621
	Appellants:	Jeffery Enright, et al.
	Title:	System and Method for Capturing and Searching Image Data Associated with Transactions
	Docket No.:	D-1112 R2 DIV

Sir:

Please find enclosed a Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer dated June 19, 2006 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of this Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	)	
Jeffery Enright, et al.	)	
	)	
Application No.: **10/603,266**	)	Art Unit 2621
	)	
Confirmation No.: **7160**	)	
	)	Patent Examiner
Filed: **June 23, 2003**	)	Anand Shashikant Rao
	)	
Title: **System and Method for Capturing**	)	
and Searching Image Data	)	
Associated with Transactions	)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning

the above-referenced Application. This Reply Brief is in response to the Examiner's Answer

("Answer") dated June 19, 2006.

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REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is

Diebold, Incorporated, an Ohio corporation.

STATUS OF CLAIMS

Claims 1 and 68-89 are pending in the Application.

    Claims rejected: 1 and 68-89

    Claims allowed: none

    Claims confirmed: none

    Claims withdrawn: none

    Claim objected to: none

    Claims canceled: 2-67

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented in this appeal are:

1).   Whether claims 1, 68-70, and 72-89 are unpatentable pursuant to 35 U.S.C. §

103(a) over Gustin, et al. (US 5,897,625) (hereinafter "Gustin") in view of

Anderson, et al. (US 6,209,095) (hereinafter "Anderson").

2).   Whether claim 71 is unpatentable pursuant to 35 U.S.C. § 103(a) over Gustin in

view of Anderson.

Additional Comments

The Answer states (on page 11) that claim 71 is rejected over Gustin in view of

Anderson. The Answer (on page 22) additionally states that "Cook was not relied upon". The

Answer's comments on page 22 are directed to Appeal Brief pages 32-33, which in turn are

directed to claim 71. However, in the Office Action (dated August 17, 2005) from which appeal

was taken, claim 71 was rejected over Gustin in view of Anderson and Cook (US 5,860,068).

Unless the record is amended to clearly state that claim 71 is now rejected over only

Gustin in view of Anderson (which would constitute a new ground of rejection, and thus require

reopening of prosecution), Appellants will presume that the appealed rejection of claim 71

remains. That is, to avoid even further delay caused by the Office, the Appellants will presume

that the Answer contains typographical errors, and that claim 71 continues to be rejected over

Gustin in view of Anderson and Cook. Thus, as best understood, the issue regarding the

rejection of claim 71 (issue #2) will be viewed by Appellants as follows:

2).   Whether claim 71 is unpatentable pursuant to 35 U.S.C. § 103(a) over Gustin in

view of Anderson and Cook (US 5,860,068).

ARGUMENT

The grounds of rejection of claims 1, 68-70, and 72-89 set forth in the Answer (at pages 3-11) appear to be identical to the grounds previously presented (at pages 2-10) in the Office Action dated August 17, 2005, from which appeal was taken. As discussed above, as the Answer is best understood, the Appellants also presume that claim 71 is rejected over Gustin in view of Anderson and Cook. Thus, Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in their Appeal Brief filed on January 12, 2006. Therefore, please note Appellants' previously filed Appeal Brief arguments regarding all the issues of record. Appellants' Appeal Brief is herein incorporated by reference.

<u>Appellants' Reply to the "Response to Argument" section of the Answer</u>

The Answer includes a "Response to Argument" section beginning on page 12. However, this section provides no new support for the rejections. The Office still has not provided any evidence or factual support for a *prima facie* conclusion of obviousness. Furthermore, the "Response to Argument" section of the Answer only addresses a portion of the many arguments made in support of allowance in the Appeal Brief.

Appellants have chosen to disregard the Answer's negative personal comments, which are not true. Appellants' remarks rely on legal facts of record, instead of derogatory comments. The record shows that Primary Examiner Rao has already twice allowed this application (and the currently pending claims). As evidenced by the record, including the two withdraws from issue, it appears that USPTO management has (for unknown reasons) obliged the Examiner to unwillingly reject the application. In such a situation an Examiner's frustration is expected and understandable. However, the Examiner's frustration pales in comparison to that of Appellants'.

The Appellants did not cause this application to be twice withdrawn from issue. Appellants even paid the issue fees. Thus, Appellants respectfully request that the Examiner's frustration be directed away from them and toward a more responsible target, such as the source of the issue withdrawal. The Examiner's previously stated reasons (set forth in the Notice of Allowances dated May 18, 2005 and April 5, 2006) as to why this application should be allowed continue to remain true.

Claim 1

The Answer addresses claim 1 from page 12, line 14 to page 17, line 12. Appellants reply to the Answer's remarks regarding claim 1 follow.

Reply to the Answer's remarks at page 12, line 14 to page 13, line 5

Appellants respectfully submit that the Examiner misinterprets both Appellants' arguments and claim 1. In the Appeal Brief, Appellants discussed Gustin's operation in order to show how the recited subject matter differed therefrom. The Answer does not refute the description of Gustin provided by Appellants (at Appeal Brief pages 12-14).

Further, in spite of the Examiner's allegation, Appellants never argued that claim 1 included the language "generated as a confirmation means to send over the banking network". Instead, the language originates from the Office. In the Office Action dated August 17, 2005 from which appeal was taken (hereinafter "Action"), the Examiner (on page 3, lines 2-5; and corresponding Answer page 4, lines 7-10) referenced Gustin at section col. 13, lines 39-55. The Examiner cited the section to allege that "Gustin discloses that the document is a tagged file document . . . that is generated as a confirmation means to send over the banking network". That is, the Examiner alleged that Gustin sent a TIFF image file over the banking network. Appellants

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(beginning at Appeal Brief page 14, line 11) rebutted this extra feature attributed to Gustin, because the rejection of claim 1 is improperly based thereon. The Answer's acknowledgment that the language "generated as a confirmation means to send over the banking network" is not recited in claim 1 further confirms that the Office's reliance on Gustin for such feature (even if it were somehow taught by Gustin as alleged, which it isn't) to reject the claim is without merit.

As discussed in the Appeal Brief (and not refuted by the Office), Gustin's TIFF image file is not sent over the banking network. Rather, the image file is magnetically stored locally in the ATM (Gustin's claim 31; col. 13, lines 1-4). Gustin uses conventional transaction communication formats, not communication via image files. Gustin teaches that the image file is locally stored with an identifying tag so that it can be later accessed from local storage if necessary, as is conventional.

The Examiner's comment (beginning at Answer page 12, last line) that "All that the claim requires is that a markup document is formed" is duly noted. It would appear that a Primary Examiner would have to intentionally misinterpret claim 1 to make such a comment. Nevertheless, as shown in more detail throughout the Reply Brief, this comment is merely reflective of the impropriety of all the rejections on appeal.

<u>Reply to the Answer's remarks at page 13, line 6 to page 14, line 2</u>

The Examiner misinterprets Appellants' arguments. In spite of the Examiner's allegation, Appellants never argued that claim 1 had a "signature verification" limitation. The Answer conveniently does not state the specific Appeal Brief location of "the Appellant's argument that Gustin fails to address the signature verification . . . limitation of the claim". Nor does the Appeal Brief contain such argument. Again, Appellants discussed how Gustin operates in order

to show how the subject matter claimed is different therefrom. The Office's discussion of "signature verification" with respect to Gustin and claim 1 is unclear and is not pertinent to the subject matter recited in the claim.

Appellants respectfully disagree with the Office's allegation (at page 13, lines 15-16) that "Gustin converts scanned indicia into a character string . . . and further transmits such information to the bank for confirmation purposes." Gustin does not convert "scanned indicia into a character string" and then transmit "such information to the bank for confirmation purposes," as alleged. In Gustin, confirmation of the check as valid occurs locally at the ATM level. As explained in the Appeal Brief, Gustin's ATM has both character recognition software and verification software. The character recognition software analyzes a scanned check image to accurately predict individual characters within a "preset confidence level" (col. 13, line 41). Gustin's predicted/estimated individual characters are then grouped together as character strings (which would likewise have their own cumulative confidence level). As discussed in the Appeal Brief, a generated string is then used by the ATM's verification software to compare the predicted written signature on the check with the user's signature of record, and further to compare the predicted written amount on the check with the amount inputted to the ATM by the user. These comparisons are performed at the ATM to help the ATM determine whether the check should be verified as valid.

However, Gustin does conventionally use the banking network to determine (col. 16, lines 43-45) if the checking account has sufficient funds to cover the check amount inputted to the ATM by the user. As is conventional in the art of transaction processing, the banking network compares the check amount against the checking account balance, and then informs the

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ATM whether the check amount is covered. After receiving "confirmation for payout" (Gustin at col. 13, line 47) from the banking network, the ATM pays out the check amount. Thereafter, the ATM sends a "confirmation on the current transaction" (Gustin at col. 13, lines 53-54) to the banking network that payout was completed. It should be understood that even after receiving confirmation, for various reasons (lack of cash, dispenser failure, user canceling the transaction, etc.) the ATM may not be able to carry out the payout. Thus, there is a need for the ATM to confirm to the banking network that payout was actually performed. Once informed of the actual ATM payout, the banking network then officially commits the accounts involved in the transaction to financial settlement. Again, in Gustin the communication between the ATM and the banking network (and what is communicated) is conventional.

Reply to the Answer's remarks at page 14, lines 13-22

The Answer (at page 14, lines 16-19) alleges that "Anderson discloses that the electronic documents are generated from scanned paper checks using check imaging means (Anderson: column 7, lines 40-50). These imaged check are then *converted* to markup documents using Anderson's FSML language (Anderson: column 18, lines 60-67; column 19, lines 1-20)".

Appellants respectfully disagree with the extra features attributed to Anderson by the Office. For example, Anderson does not convert an imaged check to a markup language document, as alleged by the Office. The Office's first relied citation (i.e., Anderson at col. 7, lines 40-50) is from Anderson's "Background" section and merely refers to prior art (e.g., Gustin's) imaging of a paper check. This section does not relate in anyway whatsoever to a markup language document or to Anderson's markup language (FSML) invention. The scanning of a paper check is referred to only once in the entire Anderson patent, and even then only as

prior art in the Background section. It is not a part of Anderson's markup language system, but rather indicated inferior thereto by Anderson.

As shown in more detail later, a critical error in the rejection presented by the Office is the Office's incorrect reliance on Anderson for teaching that a paper check is first scanned and thereafter the check image is then converted (using FSML) to a markup language document. If this were true then why does the Office rely on Gustin? If Anderson did not find it obvious to link a paper check (and its image) to a markup language document, then why does the Office think it would suddenly become obvious to do such by replacing Anderson's imagining device (at col. 7, lines 40-50) with Gustin's imagining device (55)? Anderson actually teaches against using a paper check (and its image) with his FSML system (e.g., col. 15, lines 40-43). That is, Anderson specifically teaches away from that which the Office alleges as obvious.

Again, Anderson does not convert an imaged paper check to a markup language document, as alleged by the Office. The Office's second relied upon citation (i.e., Anderson at col. 18, line 60 to col. 19, line 20) reads as follows:

> "standard personal computer and a common web browser 408, a user can access dynamic applications and content that are stored on the web server.
> A Financial Services Markup Language (FSML) has been developed to allow for the creation of electronic documents that are human readable and machine readable and processable. FSML is a markup language according to the SGML standard. By using FSML, one can create, sign and process electronic documents. In an embodiment of the invention, the electronic documents may be electronic checks, and FSML may be used to create, sign and process electronic checks and their associated documents. In other embodiments, the documents may be medical records, loan applications, contracts, or the like. The creation of the electronic documents uses a block structure as noted below. The signing of the electronic documents can employ a public key cryptographic

signature and hash algorithm to provide security attributes. The FSML signature mechanism also allows documents to be combined, or added to, without loss of the security attributes. The processing (e.g., signature verification, endorsements, authentication, payment, etc.) of the electronic documents is also automated.

The FSML documents are ASCII documents that are both human readable and machine readable and processable. ASCII encoding of data items provides integer, hex, real, string and boolean types. Tags and values are readable without special software. SGML escape sequences permit internationalization. ASCII formats are compatible with electronic mail transaction as well as with V.42bis and other data compression."

Where in this relied upon section does Anderson convert an imaged paper check to a markup language document, as alleged by the Office? The evidence of record shows that the relied upon section of Anderson does not provide support for the allegation made (nor support for the rejection).

Appellants challenge the Office to particularly point out any section of the patent where Anderson converts an imaged paper check to a markup language document. The Office has continually failed to produce support for the allegation because it can't. Even the Examiner has twice confirmed this deficiency in the rejection in his reasons for allowance statements. The rejection is based on an unsupported false premise.

Reply to the Answer's remarks at page 15, lines 1-13

The issue is whether Anderson's FSML system requires manual labor to create an electronic check. If true, then the rejection would be improper because Anderson's reliance on a manual system would not be applicable with Gustin's fully automated system. The Office takes

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the position that Anderson's FSML system is automated, with automatic conversion of an imaged paper check into a markup language document. However, the facts of record show that the Office's position is not correct.

As discussed in detail in the Appeal Brief, Anderson's proprietary Financial Services Markup Language (FSML) is used by a person to initially create (from scratch) an electronic check (there is no form of preexisting check). Anderson teaches that in his system a personal check (74) is electronically created by a person (e.g., payer 12) who manually uses a workstation (90) to create the check (col. 23, lines 42-45; col. 24, lines 51-54). That is, a person manually enters the needed data. Again, Anderson does not automatically convert an imaged paper check into a markup language document, as alleged by the Office.

Also note Anderson's teaching that "an electronic check is typically created with a template document . . . The bottom portion 107 of the template contains field that *the payer completes* to prepare the electronic check" (col. 25, lines 39-44), "the *payer* can use a . . . word processor and other application, such as Quicken, to *create* a properly formatted electronic check" (lines 51-53), and "the template is *filled in by the payer*" (lines 54-55). Additionally note Anderson's teaching that "The use of electronic documents will be more cost effective than existing paper documents . . . significantly reduced costs of creating and mailing a document" with "*no check stock*" or check "photocopies" (i.e., check images) needed (col. 15, lines 35-43). Further note that in Anderson an "electronic check is . . . *initiated* and routed electronically, uses digital signatures" (col. 23, lines 5-7); "The invention provides an all-electronic . . . instrument that can be *initiated* from a variety of devices, such as a . . . screen phone, ATM" (col. 14, lines 23-28); FSML was developed to allow for the manual creation of electronic checks so that "By

using FSML, one can *create*" an electronic check (col. 18, lines 63-67); and "an electronic check, may be *created . . .* at a computer terminal" (col. 24, lines 51-53).

Appellants have presented overwhelming evidence that in Anderson a machine does <u>not</u> automatically convert data obtained from an existing (already created) paper check into a markup language document, as relied upon by the Office in the rejection. Nor does manually inputting data at an ATM (which Anderson teaches are on a proprietary network at col. 38, line 33) make Anderson's system automated (e.g., Anderson at col. 14, lines 26-28), as alleged by the Office. Anderson's electronic check can't replace Gustin's character strings. Gustin's system is fully automated, not manual. The strings are determined and formed automatically by the ATM, not manually. Using Anderson's manual input of check data, a person in Gustin would have to access Gustin's ATM interior (where Gustin's automation occurs) and at just the right moment manually enter the data. It follows that the rejection (which is based on the unsupported allegation) is improper.

Anderson can't have automated input of check data because there is no existing check data to input automatically. In Anderson the (previously non existent) check data is created as it is being manually input. There is no paper check either before or after the electronic check is created. Conversely, Gustin's system can be automated because it uses a paper check that already exists.

Additionally, why would Gustin bother with his actual invention (i.e., check imaging, analyzing the image, and forming character strings) if a person had to manually enter the check data (as required by Anderson) directly from Gustin's paper check (or the check image). The addition of Anderson's teaching to Gustin (if somehow possible, which it isn't) would discard

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Gustin's entire invention. Actually, Anderson's invention *does* teach the discarding of systems like Gustin's (i.e., relying on paper checks, imaging, etc.).

Apparently the Examiner recognizes the deficiency in the allegation concerning Anderson's system being automated (and the resulting improper combination of the divergent reference teachings). Thus, the Answer disclaims that "even if Anderson's system was manual. . . making something automated that was once manual is obvious". Without any evidentiary support (or explanation as to how Anderson could be automated when it requires manual input), the Answer further states that "one of ordinary skill in the art would have made the obvious modification to automate the Anderson system prior to its incorporation with Gustin since Gustin itself is automated". Appellants take these Answer statements as an admission by the Office that Anderson does not teach or suggest the features relied upon for rejection.

Reply to the Answer's remarks at page 15, line 14 to page 16, line 3

The issue is whether Anderson's system is properly combinable with Gustin's system, or whether the alleged combination would result in an improper rejection by destroying Gustin's disclosed and desired functional ability.

Appellants have already shown factual evidence that in Anderson's markup language (FSML) system the check data is manually inputted. Anderson even teaches against using paper checks with the FSML system (col. 15, lines 40-43). Thus, Anderson doesn't require or need (and teaches against using) a check scanning device with the FSML system. However, using a check scanning device (55) is critical to Gustin's invention.

If it were somehow possible (which it isn't) for Gustin to use Anderson's FSML system teaching as alleged, then what purpose in Gustin would a check imaging device serve? The

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answer is none. That is, the Office's proposed modification of Gustin with the teachings of Anderson would result in the removal of a (now unnecessary) critical component (imaging device 55) from the disclosed teaching of Gustin. However, Appellants' claim 1 (and others) requires an imaging device. It follows that the alleged modification to Gustin not only wouldn't have produced the recited invention (having an imaging device), but would have also destroyed the explicit teaching of Gustin. Thus, the rejection is legally improper.

The statement in the Answer (at page 16, lines 1-3) that Anderson's "checking scanning machine . . . would be combinable with Gustin" is off base and out of context. First, as previously discussed, paper check scanning is not a part of Anderson's markup language system. Anderson actually teaches that his superior markup language (FSML) system renders as obsolete prior art (like Gustin's) paper check scanning (and paper check usage). Secondly, simply exchanging one paper check scanner (Gustin's paper check scanner 55) for another paper check scanner (Anderson's mentioned prior art paper check scanner) would not have resulted in the recited invention.

Reply to the Answer's remarks at page 16, lines 3-12

As discussed in the Appeal Brief, Gustin does not transmit image files over the banking network. Rather, Gustin uses conventional transaction communication formats, not communication via image files. Gustin's check images are magnetically stored locally in the ATM (Gustin's claim 31; col. 13, lines 1-4).

The Answer alleges that "Gustin discloses does disclose [sic] transmitting character strings over the network wherein these strings are used for transaction verification (Gustin: column 13, lines 40-50)". The Office then reasons that "since Gustin discloses transmitting

transaction information back to the bank across the network, one of ordinary skill in the art now using Anderson's teaching of formatting the transaction information into a markup language document would be compelled to transmit those markup language documents back to the banks across the network as shown by Gustin". Appellants respectfully disagree.

Appellants have already discussed Gustin's conventional character strings, and what data is sent over the banking network. Gustin teaches that character strings *representative* of recognized characters (not the actual characters) are created by the character recognition software for use by the verification software. The character recognition software and verification software are both in the ATM. Later, after the check has been verified by the ATM, other strings *representing* that the signature was verified (not the actual signature) as well as *representing* the (inputted) amount of the check are sent in a request from the ATM to the banking network for a "confirmation for payout". Gustin does not transmit a check image to the banking network. The check image is stored in the ATM (e.g., Gustin's claim 31; col. 13, lines 1-4). Nor are Gustin's representative strings checks. Nor is there any evidence of record that Anderson's manually created electronic checks could replace these representative strings.

As previously discussed, Gustin's "confirmation for payout" is a request from the ATM to the banking network asking if the checking account has sufficient funds to cover the sent check amount. Following confirmation from the banking network, payout (of the cash) can be made by the ATM. Again, Gustin's communication with the banking network is conventional and does not include image transfer or a markup language document.

<u>Reply to the Answer's remarks at page 16, line 13 to page 17, line 12</u>

The Answer maintains that the rejection is not based on improper hindsight reasoning that uses knowledge gleaned from Appellants' disclosure. The Appellants respectfully disagree. The Answer relies on *In re McLaughlin* (1971) but ignores current case law. For example, the rejection is not based on prior art evidence of record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Not only is the rejection based on improper hindsight, but a *prima facie* case of obviousness has not been established. Which reference produces a markup language document corresponding to a (already existing) check that was *received* in a cash dispensing automated banking machine, especially a check that is imaged by an imaging device in the machine? Further, which reference operates a computer connected with a check imaging device to produce the recited markup language document? It is interesting to note that the "Response to Argument" section of the Answer never addresses the actual claim 1 language.

<u>A *prima facie* case of obviousness has not been established</u>

There is no teaching, suggestion, or need for Gustin to send a markup language document having display instructions to Gustin's banking network. Conversely, Gustin teaches that a check image is stored in the ATM (e.g., Gustin's claim 31; col. 13, lines 1-4). A check image is not displayed at the banking network. Nor does Gustin's banking network need to display a check image or receive instructions on how to display a check image. Thus, Gustin's banking network doesn't need a markup language document.

The Office alleges that Gustin's banking network consists of multiple computers connected together (Answer page 19, line 16 and page 20, lines 9-10). These computers (with

conventional automated computer-to-computer network communication) don't need to display Gustin's check image to perform their functions of (1) determining if the checking account has sufficient funds to cover the check amount, and (2) later performing accounts settlement.

Gustin teaches sending a simple data request to the banking network. Gustin's request to the banking network comprises an inexpensive low bandwidth data string. The request doesn't include or need markup language display instructions, especially display instructions corresponding to a check image that remains locally stored at the ATM (and not network accessible). Nor does Gustin's banking network need display instruction data in a markup language document. Thus, there is no need for either Gustin's ATM to send a markup language document to the banking network, or for Gustin's banking network to receive a markup language document from the ATM.

The applied references do not teach or suggest (if it were somehow possible, which it isn't) having Gustin add the unnecessary steps of manually (as taught by Anderson) converting basic string data into one of Anderson's complex electronic checks, and then sending the electronic check as a markup language document to the banking network. Nor is there any evidence of record that Gustin's banking network could receive and handle an electronic check of Anderson.

Nor could Gustin's string data (comprising basic data) be converted into one of Anderson's electronic checks. The string data does not contain enough information to enable creation of an electronic check. Anderson's electronic check template (105; Figure 5) requires manually inputted data for many check fields in order to create a completed electronic check (110; Figure 6). Gustin's string that is sent to the banking network for confirmation for payout

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only contains "signature verification" (which is not a check field) and check "amount". Thus, even if it were somehow possible (which it isn't) for Gustin's ATM to provide the additional steps required to convert the data used in the string into one of Anderson's electronic checks, an incomplete electronic check (and unusable in Anderson's system) would have resulted.

The Office has not explained why one skilled in the art would have even attempted to modify Gustin to cause the sending of a markup language document containing display instructions to the banking network, especially display instructions that correspond to an inaccessible check image kept at the ATM and display instructions that are not needed by the banking network in carry out its financial function on behalf of the ATM.

One having ordinary skill in the art would recognize that it would not have been obvious for Gustin to create and send (if somehow even possible, which it isn't) to the banking network a markup language document, especially when: (1) creation of a markup language document in Gustin is not needed because the disclosed simple low-expense data string is already sufficient to send data "as is" to the banking network; (2) data in an electronic check would be incomplete and render the electronic check unusable; and (3) display instructions (in a markup language document) would not be needed or used by the banking network because Gustin's check image is stored and kept locally at the ATM. No purpose would be served by having Gustin's banking network receive markup language document instructions on how to display a check image if the check image itself can't be received from Gustin's ATM.

The attempted modification of Gustin is unreasonable and without merit. The record is devoid of the requisite proper motivation for the alleged Gustin modification and the claim rejection. The Office has not factually established a *prima facie* case of obviousness.

<u>It would not have been obvious to have combined the references as alleged</u>

Gustin and Anderson both have transaction processes that comprise a beginning and an end. Gustin's beginning has a paper check. Gustin's end result is a TIFF image file of the paper check being stored locally in the ATM. In order to get from Gustin's beginning step to Gustin's end step the paper check must be scanned. Gustin's end result does not include a markup language document. A TIFF image file is not a "markup language document" (e.g., claim 1). Gustin does not teach, suggest, or need a markup language document.

Anderson's beginning has no paper check but rather an empty electronic check template, to which a person has to manually input/create check data. Anderson's end step results in a created formatted electronic check. In order to get from Anderson's beginning step to Anderson's end step a unique markup language (FSML) is used. That is, Anderson's FSML is used to create the electronic check (e.g., col. 18, lines 63-67).

No part of Gustin's check transaction process is compatible with any part of Anderson's check creation process. Nor is there any overlap or linking between the different processes. The formats used (TIFF and FSML) are structurally and functionally incompatible, and any combination thereof not enabling. One system (Gustin) is paper based while the other system (Anderson) is electronically based.

Even if combination were somehow possible (which it isn't), there is no teaching or suggestion for forgoing Gustin's critical automated imaging device in his process and replacing it with Anderson's manual input of data, as previously discussed. Nor can a recited feature of Appellants' claim (e.g., the imaging step in claim 1) be discarded.

There is no teaching or suggestion that Anderson's FSML could convert Gustin's TIFF image file into Anderson's electronic check format at Gustin's process ending. Nor could it.

There is no teaching or suggestion for adding a paper check (or a captured image thereof) at either Anderson's process beginning or ending. A recited feature (e.g., claim 1) is "receiving a check into an automated banking machine". Neither a paper check nor a captured image thereof would serve any purpose in Anderson's system. Data would still have to be manually inputted to initially create a check in Anderson's system. Further, Anderson's invention specifically teaches against using paper checks (and thus any imaging thereof). It follows that it would not have been obvious to have combined the references to have produced the recited invention of claim 1.

Claim 68

The Answer indicates that Appellants argued "that the references fail to assert the use of correlation of transaction data through the use of the computer (Brief of 1/12/06; page 20, lines 13-20)". Appellants respectfully request that their clear Appeal Brief arguments not be defiled by the Office. Instead of the partial language quoted in the Answer, the Appeal Brief (at page 20, lines 13-20) actually states that "The references . . . do not teach or suggest . . . *correlating* transaction data corresponding to *input from a user* (from whom the check is received) *with a markup language document*, through operation of a computer". Again, the Answer addresses neither Appellants' Appeal Brief argument nor the actual claim language.

Claim 69

Claim 69 depends from claim 68/1. Neither reference stores the produced markup language document (of claim 1) and the transaction data (of claim 68) in an ATM, as alleged by the Office.

Claim 70

The Answer (on page 18) states that Gustin's banking network "would obviously include a server or two". The allegation is without merit. *In re Zurko*, supra. *In re Lee*, supra. Banking networks existed before servers. Which reference teaches or suggests transmitting a markup language document from an ATM due to operation of a server, as alleged by the Office?

Claim 72

The Answer is silent as to which reference teaches or suggests authenticating information in a markup language document. The rejection's reliance on Gustin is misguided. Gustin doesn't have a markup language document. Even the Answer (e.g., at page 4, lines 10-11) admits such fact.

Claim 73

The references further do not teach or suggest causing a cash dispenser to operate in the manner recited.

Claim 74

Claim 74 is directed to operating a terminal remote from the automated banking machine to receive the markup language document. The Answer relies on Gustin. The Answer alleges that Gustin's banking network has multiple (undefined) "units" connected together, with each unit being a "terminal".

One skilled in the art would recognize what constitutes a "terminal", especially in light of Appellants' specification (e.g., terminal 52, 236). As previously asked in the Appeal Brief, why would an automated banking network (with conventional automated computer-to-computer

network communication) need to use/operate a separate terminal, as apparently alleged by the Office?

The Answer also alleges that other ATMs are connected to the banking network, with each ATM being a "remote terminal". Even if true, where does Gustin teach or suggest operating an ATM to receive a markup language document from another ATM? It doesn't. Nor is claim 74 obvious.

Claim 75-84

Appellants traverse the Answer's comments regarding claims 75-84 because they are not directed to the actual claim language. Instead, the comments appear to reiterate those comments made with regard to claim 74, which were already addressed by Appellants.

Claim 85

Claim 85 was not addressed in the Answer.

Independent claim 86

The Answer has failed to present any rebuttal to Appellants' arguments. As explained in the Appeal Brief, neither Gustin nor Anderson, taken alone or in combination, teach or suggest a computer of a cash dispensing automated banking machine that is selectively operative, responsive to user inputs, to cause an image of a check to be captured through operation of an imaging device of the machine, and to produce a markup language document corresponding to at least a portion of the captured image. The references don't teach or suggest a markup language document that corresponds to a captured image of a check.

Appellants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, Anderson cannot alleviate the admitted deficiencies in Gustin.

Independent claim 87

The rejection did not address all of the recited features, nor provide a prior art showing thereof. On this basis alone the Office did not factually establish a *prima facie* case of obviousness. Now the Answer continues the failure of not establishing a *prima facie* case of obviousness. The Answer does not present any rebuttal to Appellants' arguments. As explained in the Appeal Brief, neither Gustin nor Anderson, taken alone or in combination, teach or suggest a data store of check transaction data; and a check analysis terminal having a computer operative to receive a markup language document having additional check transaction data, store the received additional data in the data store, and display stored check transaction data responsive to input to the check analysis terminal.

Appellants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, Anderson cannot alleviate the admitted deficiencies in Gustin.

Claim 88

As discussed in detail in the Appeal Brief, nothing in the references teaches or suggests an automated banking machine that produces a markup language document that includes check transaction data corresponding to an image of a check.

Claim 89

The rejection relies on Gustin's teaching. However, where does Gustin, responsive to input to a check analysis terminal, display a stored check image that was received in a markup language document? As admitted by the Office (e.g., Answer at page 4, lines 10-11), Gustin doesn't even have a markup language document.

Claim 71

The Answer addresses claim 71 on page 22. However, the Office has provided no teaching or suggestion to modify Anderson to use XML in view of Cook. Cook (published January 12, 1999) was even available to Anderson at the time of Anderson's (August 31, 1999) filing. There isn't any evidence of record that Anderson's unique language (FSML) is similar to or interchangeable with XML. Nor has any evidence been provided that Anderson's unique FSML conforms to the XML format. Rather, XML and FSML would each have a distinct functionality. Anderson requires the unique financial language FSML for financial viability, not XML. It would not have been obvious to have combined the references (Gustin, Anderson, and Cook) as alleged to have produced the recited invention.

Summary

For reasons presented herein and in the Appeal Brief, the Appellants respectfully disagree with the Office's allegations and reasoning. The Appellants are not required to prove patentability. Appellants respectfully submit that the record lacks the requisite supporting evidence, especially concrete evidence, to sustain the rejections. The Office has not established a *prima facie* case of obviousness under the law. It would *not* have been obvious to one having

ordinary skill in the art to have modified the references as alleged to have produced the recited invention.

More detailed remarks regarding all the issues of record, including support for the patentability of each claim, can be found in the Appeal Brief. Again, attention is directed thereto for additional reasons as to why the references do not render obvious the appealed claims.

Additional Comment

It is unclear how the Office can both hold an appeal conference and write an Examiner's Answer all while the concerned application has an allowed status, especially with prosecution being closed. Unfortunately, this appears to be the situation concerning Appellants' application.

The last page of the Examiner's Answer is dated June 12, 2006. This date indicates that the appeal conference and the Examiner's Answer were completed prior to or on June 12, 2006. However, the (second) Notice of withdrawal from issue has the later date of June 13, 2006. Appellants respectfully submit that it is plainly improper for the Office to hold an appeal conference on an allowed application, and that the Office's handling of Appellants' allowed application constitutes arbitrary and capricious action against Appellants.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features thereof to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Furthermore, as previously discussed, the record shows that USPTO management has twice caused the Primary Examiner to withdraw this application from issue. Appellants request the Board of Patent Appeals and Interferences to vindicate the prior conclusions of allowability by the Primary Examiner and reverse the rejections.

Respectfully submitted,

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